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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/087,256 | 03/01/2002 | Kishan Khemani | 11527.354 | 4244 |

22913 7590 11/02/2006

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| EXAMINER |
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SEIDLECK, JAMES J

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| ART UNIT | PAPER NUMBER |
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1711

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/087,256

Applicant(s)

KHEMANI ET AL.

Examiner

Ana L. Woodward

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/15/2004
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-28 is/are pending in the application.
- 4a) Of the above claim(s) 6, 13, 27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 7-12 and 14-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 6, 13, 27 and 28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 24, 2004.

Allowable Subject Matter

2. The indication of allowable subject matter per the telephonic conversation with Mr. John M. Gynn on September 26, 2006 is withdrawn in view of the newly discovered reference(s) to U.S. 6,787,613 (Bastioli et al) and U.S. 6,962,950 (Bastioli et al). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 23-25 remain rejected under 35 U.S.C. 102(a and/or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 6,348,524 (Bastioli et al) as per reasons of record.

6. Claims 1, 5, 7-12 and 23-25 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 6,787,613 (Bastioli et al).

Bastioli et al disclose mixtures of biodegradable polyesters, and films therefrom, which include

(A) an aromatic-aliphatic polyester, e.g., Ecoflex 0700, reading on the presently claimed soft copolyester,

(B) an aliphatic polyester, e.g., polybutylenesebacate, reading on the additional soft polymer presently claimed (per claims 11, 12), and

(C) a polylactic acid polymer, reading on the presently claimed stiff polymer, in which the concentrations of A varies with respect to (A+ B) in the range between 40 and 70% by weight, and the concentration of C with respect to (A+B+C) is of between 6 and 30% by weight.

In Table 1 various film formulations meeting the requirements of the present claims both in terms of the types of materials added and their contents are exemplified. Example 7 containing 40% polylactic acid with respect to 20% Ecoflex would meet the amount requirements per claims 5 and 7. Given that the polymers used by patentees are the same as those used by applicants, it is reasonable to believe that they would inherently meet the glass transition and melting point requirements presently claimed. The onus is shifted to applicants to

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establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

7. Claims 1, 8-10, 12, 14 and 19-25 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 6,962,950 (Bastioli et al).

Bastioli et al disclose compositions, and films therefrom, which include

(A) a hydrophobic polymer matrix formed from a hydrophobic polymer incompatible with starch, inclusive of aromatic-aliphatic polyester, e.g., Ecoflex, reading on the presently claimed soft copolyester,

(B) a starch complex, obtained by extrusion of starch with a complexing thermoplastic polymer, preferably having a glass transition temperature below 0°C, reading on the presently additional soft polymer per claim 12 or additional filler component (per claims 14, etc.), and

(C) a coupling agent.

Example 18 comprises a film formulation comprising maize starch, reading on the presently claimed generic additional soft polymer or on the filler component per claims 14 and 19-22, Ecoflex, reading on the presently claimed soft copolyester, and lactic acid polymer or copolymer, reading on the presently claimed stiff polymer. It is maintained that said embodiment meets the requirements of the present claims both in terms of the types of materials added and their contents. Given that the polymers used by patentees are the same as those used by applicants, it is reasonable to believe that they would inherently meet the glass transition and melting point requirements presently claimed. The onus is shifted to applicants to establish that

the product of the present claims is not the same as or obvious from that set forth by the reference.

Claim Rejections - 35 USC § 103

8. Claims 14-22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,787,613 (Bastioli et al), described hereinabove.

As to the requirement for organic or inorganic fillers, it should be noted that Bastioli et al clearly disclose and suggest the further incorporation of said additives (in amounts inclusive of applicants' preferred amounts) to their compositions (column 5, lines 2-23). Accordingly, absent evidence of unusual or unexpected results, no patentability can be seen the subject matter of claims 14-22.

Regarding the additional soft aliphatic polyester per claim 26, it is maintained that succinate-based aliphatic polyesters are within the scope of patentees' general disclosure of their diacid/diol aliphatic polyesters and, as such, obvious to one having ordinary skill in the art. Accordingly, no patentability can be seen therein.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,962,950 (Bastioli et al), described hereinabove.

It is maintained that it would have been obvious to one having ordinary skill in the art to have employed a starch complex governed by a glass transition temperature less than about -20°C as per such being implicitly included in the reference's general disclosure of glass transition temperatures preferably below 0°C (column 2, lines 66-67). Accordingly, no patentability can be seen therein.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1, 5, 7-12 and 14-26 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 11/103,999. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain overlapping subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

12. Applicant's arguments and amendments filed September 15, 2006 have been fully considered and are persuasive to the extent that the 35 USC 112 rejections and art rejections over Lorcks et al and McCarthy et al have been withdrawn.

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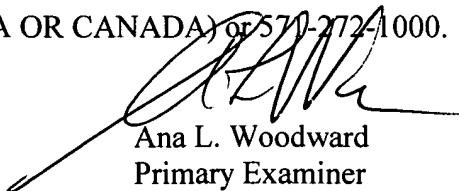
As to the rejection of claims 23-25 over Bastioli et al '524, it is maintained that the natural starch disclosed by the reference reads on the presently claimed stiff polymer. In this regard, it is noted that stiff polymer per claim 23 is inclusive of synthetic as well as natural polymers and the stiff polymer per claim 25 specifically includes thermoplastic starch that is free of high boiling liquid plasticizers as a suitable stiff polymer.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ana L. Woodward
Primary Examiner
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